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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,912	12/15/2000	Peter Michael Karas	10722-31459	2437

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EXAMINER

NGUYEN, CUONG H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/737,912

Applicant(s)

KARAS ET AL.

Examiner

CUONG H. NGUYEN

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is the answer to the amendment submitted on 11/26/2003. This paper has been placed of record.
2. Claims 1-29 were pending in this application. Claims 9-10 are cancelled.

Response to the amendment:

3. The submitted arguments on 11/26/2003 are unpersuasive since rejected limitations of claims 9-10 (cancelled claims) are added to rejected independent claims 1, and 17; that still do not make these claims avoid obvious rejections. The examiner maintains old references for rejections, and giving rationales and references for newly added claim 29 herein; the invention's concept is to sent money with a personal message on Internet – this act is old and well-known with sending money orders and the use of Internet for transaction is old and well-known. It would be obvious one with ordinary skill in the art to send money together with personalized messages via Internet (knowing that sufficient admin. Tasks already performed, such as validation ...).

Applicant's arguments on the combination of cited references are not relevant to the rejection since there is no attempt to combine any allegedly conflicting or non-referred teachings nor is there any attempt to include non-preferred steps or functions. As a result, the assertions that the combinations of Simpson, McGurl et al., and Tackbary et al., would not be proper is not relevant to the rejections since there is no attempt to alter the operation or intent of Simpson by including the particular ways of cited references' teachings.

The rejection follows the Graham v. Deere inquiries by determining the

scope and content of the prior art, determining the differences between the prior art and the claims at issue and resolving the difference in light of the level of ordinary skill in the art. While the particular data claimed is not identical to that in the reference, it would have been recognized by those of ordinary skill in the art that any difference does not create a functional distinction between the claimed method and the teaching of the claimed reference. In other words, those of ordinary skill in the art would have recognized, in light of the applied prior art, that their teachings do not alter how the recited steps in the main reference are performed. As a result, since the steps of the method and those of the prior art are effectively the same, there is no patentable distinction.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 17-28 are system claims; they are analyzed below. Method claims 1-8, and 11-16 contain analogous features of claims 17-28; therefore, similar rationales & references for (claims 1-8, 11-16) rejections on 35 USC 103(a) are applied.

A. Re. to claim 17: It is rejected under 35 U.S.C. § 103(a) as being unpatentable over Simpson (US Pat. 6,453,300), in view of McGurl et al. (US Pat. 5,893,080).

Simpson teaches a system to order and to deliver a customized greeting

message, comprising:

- (a) means for selecting an image to include in the message (this is equivalent to a computer I/O device for selecting an object; i.e., a keyboard or a mouse capable of selecting a graphical object (see **Simpson**, Fig.7 – in addition, this feature is old and very well-known with computer I/O devices to do selection tasks);
- (b) & (c) means for specifying a name (e.g., for inclusion in a message) (i.e., a computer I/O device for selecting/input; i.e., a keyboard that goes with a computer for inputting data; this feature is old and very well-known, see **Simpson**, Fig.7 showing that a selection can be made by “high-lighting” a word/(a group of text)” and pressing a macro-function key (a predefined key), or by “clicking” a mouse button “after selecting” text/icon);
- (d) means for selecting an object using I/O devices (for selecting a money value of \$5, \$10, or \$20 (e.g., typing a monetary amount on a check with a keyboard or selecting among \$5, \$10, or \$20) - see **Simpson**, 5:5-22).
- (e) means for printing a message, and a negotiable payment instrument (e.g., a check) or **Simpson**, (see Fig.10 - it is equivalent to a computer I/O device i.e., a printer that goes with a computer; this feature is old and very well-known to be a means for printing available forms after completions); and
- (f) & (g) means for mailing the printed message and “extra attachments” (i.e., a negotiable payment instrument), (see **Simpson**, 12: 3-15 “... includes the insertion of names and other references...” to a recipient (this feature is old and well-known using an email interface and the Internet);

Simpson does not expressly disclose that “a negotiable payment” is included in said message.

However, **McGurl et al.** teach that feature (a negotiable payment) may be printed (see **McGurl et al.**, Fig.1 – ref. 36);

(c) means for specifying a payee for a negotiable payment (see **McGurl et al.**, 4:45-59); and

(d) means for selecting the monetary value of the negotiable payment; (see **McGurl et al.**, claim 21 (i.e., “generating payment disbursement data based upon a request” this obviously shows that a monetary value already been selected).

(g) The patent of **McGurl et al.** also disclose a means for specifying billing information (this is merely an indication on a specific form; it can be combined of a “matching” device and a database) for the message and the negotiable instrument, wherein the billing information includes a financial institution of the sender (this information are almost always printed); and (e) a means for requesting billing authorization (this is merely a communication device to perform authorizations – it is old and well-known to validate/receiving authorization when issuing a money order) from a finance institution/a bank of the sender (see **McGurl et al.**, 1:22-56);

Again, these above limitations are not inventive features because these claimed means are merely fundamental means to create/select specific information that would be included in attached messages (e.g., means for specifying a name (see **Simpson**, Figs. 5, 7), and means for selecting a number (a money amount) from database; these would be done with I/O devices such as

a keyboard or a mouse that always goes with a computer).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Simpson's teachings and McGurl et al.'s disclosure since extra specific information/attachment are intended of uses depending of each particular application, but the concept of merging different data is old and very well-known: merely putting a check and extra information into a paper as in a pay check (a pay stub), and delivering a document via Internet would be well-known with artisans to deliver a greeting message having a negotiable payment (in 1995-1996, when the examiner worked for a Temp. Company in Hanover, Maryland (job shop), he picked up his pay check every 2 weeks including "a banner" of "Merry Christmas", "Happy New Year", "Happy Thanksgivings" etc. this was an act of including appropriate greeting texts in a paycheck remark, instead of including a check in a greeting card – these two methods were obvious although Internet was involved - A note about automating a manual activity:

The court held that providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 120 USPQ 193, 194 (CCPA 1958).

B. Re. to claim 19: It is rejected under 35 U.S.C. § 103(a) as being unpatentable over Simpson (US Pat. 6,453,300), in view of McGurl et al. (US Pat. 5,893,080), and further in view of Tackbary et al. (US Pat. 5,960,412).

The rationales and reference(s) for 35 USC 103(a) rejection of claim 18

are incorporated.

Simpson and McGurl teach a system to order and to deliver a greeting message.

In addition, the examiner submits that **Tackbary et al.**, suggest input information are customized/modifiable using a keyboard or a mouse that goes with a computer (see **Tackbary et al.**, Fig.6a, the summary of the invention - obviously, a specific software is used to perform **Tackbary et al.**'s invention).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Simpson's teachings, McGurl et al.'s and Tackbary et al. 's disclosures since modifiable information for integrating/merging different data is old and very well-known using computer I/O devices.

C. Re. to claim 20: The rationales and reference(s) for 35 USC 103(a) rejection of claim 17 are incorporated.

In addition, the examiner submits that means for selecting an occasion for sending an email message is obvious (see **Simpson**, Figs. 6-7 about Christmas Holiday, New Year Holidays, Mother Day, Father Day, Valentine Day occasions .etc., or see **Simpson** 1:29-32, that disclosing "In the past, numerous cards, such a greeting or special occasion cards, have been available in a variety of shapes and sizes and with a variety of different decorative images, indicia and/or messages thereon").

D. Regarding claims 1, 6-7: They are method claims that contain equivalent features/steps of using an apparatus of claim 17; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth (please note that a limitation of claim 7 states: "enabling a sender to select the recipient from an address book listing available recipients" is merely a decision to make by looking

up a database – this action is obviously performed in claim 19).

E. Regarding claim 2: It is a method claim that contains equivalent features/steps of using an apparatus of claim 20; therefore, it is rejected on 35 USC 103(a) with similar rationales and references set forth (please note that claim 20 sufficiently mentions 2 limitations of selecting by a sender, and present a gift based on a selected occasion).

F. Re. to claim 18: The rationales and reference(s) for 35 USC 103(a) rejection of claim 17 are incorporated.

The examiner submits that **Simpson** teaches a means for displaying an input form (i.e., a computer monitor) (see **Simpson**, Figs. 6, 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Simpson's teachings and McGurl et al.'s disclosure to display a form with extra specific information/attachment (such as a displaying a form with monetary value of a negotiable payment instrument are intend of uses depending of each particular application, but the concept of displaying a form on a computer monitor is old and very well-known and would be used by artisans to deliver a greeting message having a negotiable payment.

G. Regarding claim 3: It contains steps that describing a use of an apparatus in claim 17; therefore, it is rejected on 35 USC 103(a) with similar rationales and references set forth.

H. Regarding claim 4: It contains steps that describing a use of an apparatus in claim 19; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

I. Re. to claim 21: The rationales and reference(s) for 35 USC 103(a)

rejection of claim 20 are incorporated.

The examiner submits that **Tackbary et al.**, suggest that graphic image and customized text could be pre-selected (see **Tackbary et al.**, Figs. 4, 6a, the summary of the invention, a customer may pre-select available image/text or customized image/text for a proper occasion (see **Tackbary et al.**, Figs. 4, 8); (please note that **Simpson** also teaches that in Fig. 7, and in his invention's summary, disclosing: "In the past, numerous cards, such a greeting or special occasion cards, have been available in a variety of shapes and sizes and with a variety of different decorative images, indicia and/or messages thereon").

One of ordinary skill in the art would combine **Tackbary et al.**, and **Simpson** and **McGurl et al.** suggestions to appreciate that more flexibility of a document's content has given to a customer's selection before sending a message.

J. Re. to claim 22: The rationales and reference(s) for 35 USC 103(a) rejection of claim 21 are incorporated.

The examiner submits that **Tackbary et al.**, or **Simpson** suggests input information i.e., graphic image and customized text are modifiable by selections (see **Tackbary et al.**, Figs. 4, 6a; or **Simpson**, the summary of the invention). One of ordinary skill in the art would appreciate that more flexibility is given to a customer in sending a message's content.

K. Regarding claim 8: It contains features that are equivalent to a use of an apparatus of claim 22 (merely able to edit information); therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

M. Regarding claim 4: It contains features that are equivalent to a use of an

apparatus of claim 19 (merely able to edit information); therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

N. Re. to claim 23: The rationales and reference(s) for 35 USC 103(a) rejection of claim 17 are incorporated.

The examiner submits that a combination of **Tackbary et al., & McGurl et al.**(Fig.1, ref. 30) suggests means for displaying a preview of the printed message and attached information (see also **Simpson**, Fig.9).

O. Regarding claim 11: It contains features that are equivalent to a use of an apparatus of claim 23; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

P. Re. to claim 24: The rationales and reference(s) for 35 USC 103(a) rejection of claim 17 are incorporated.

The examiner submits that **Tackbary et al.**, combines with **McGurl et al.** (Fig.2, ref.66 for changing a disbursement date) would be obvious to suggests means to specify a delivery date (by input a delivery date) for the message and negotiable payment instrument (e.g., payment would be in personal check .etc.).

Q. Regarding claim 12: It contains features that are equivalent to a use of an apparatus of claim 19; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

R. Re. to claims 25, 13: The rationales and reference(s) for 35 USC 103(a) rejection of claim 17 are incorporated.

The examiner submits that **Tackbary et al.**, or **Simpson** would suggest that the recipient and the payee are the same, e.g., a C.O.D. feature (see

Tackbary et al., or Simpson, the summary of the invention).

S. Regarding claim 13: It contains features that are equivalent to apparatus claim 25; therefore, it is rejected on 35 USC 103(a) with similar rationales and references set forth.

T. Re. to claims 26, 5, 14: The rationales and reference(s) for 35 USC 103(a) rejection of claim 17 are incorporated.

The examiner submits that the recipient and the payee can be different (see **Simpson**, Fig.7, 10:7- 30) (e.g., one can send an email to a receiver, and also send the same email to a payee).

U. Regarding claim 5, 14: They contain features that are equivalent to a use of an apparatus of claim 26; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

V. Re. to claims 27, 15: The examiner submits that information (e.g., negotiable payment instrument) can be an attachment of a message (an old and well-known example for this is a pay stub perforated to a pay check, from US Pat. 3,783,755, Figs. 1-2).

X. Regarding claim 15: It contains features that are equivalent to a use of an apparatus of claim 27; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

Y. Re. to claim 28: **It is rejected under 35 U.S.C. § 103(a) as being unpatentable over Tackbary et al. (US Pat. 5,960,412), Simpson (US Pat. 6,453,300), in view of McGurl et al. (US Pat. 5,893,080) , and further in view of Lugin (US. Pat. 3,783,755).**

The rationales and reference(s) for 35 USC 103(a) rejection of claim 17 are incorporated.

Tackbary et al., Simpson, or McGurl et al. do not expressly teach that "a message and a negotiable payment instrument are printed on the same paper".

Lagin teaches that "a message and a negotiable payment instrument are printed on the same paper".

The examiner submits that information (e.g., a message & a negotiable payment box) could be printed on the same paper form (for perforating - claim 27 analogously comprises this feature - e.g., a pay stub perforated to a pay check, see **Lagin**, Figs. 1-2).

It would be obvious for one with ordinary skill in the art to combine Tackbary et al., **Simpson**, McGurl et al. with an idea of Lagin because all above applications are directed toward distributing a document, and doing perforation for such a document would be convenient in printing and saving paper's space.

Z. Regarding claim 16: It contains features that are equivalent to a use of an apparatus of claim 28; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

5. Regarding new claim 29: It is a method claim that contain equivalent features in rejected claims 17, and 24; therefore, it is sufficiently rejected on 35 USC 103(a) with a combination of similar rationales and references set forth.

Conclusion

6. Claims **1-8, 11-29** are not patentable.

7. Applicant's amendment necessitated the new ground(s) of rejection

presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Related references:

A. West, (US Pat. 6,011,833 filed 8/11/1998) for a talking bouquet that sufficiently similar to the claimed invention, the differences are no authentication/validate the giving amount of money, and no use of Internet (however, these missing factors were old and well-known to be obvious in combination with West in achieving claimed results).

B. Simpson, (US Pat. 6,453,300 filed 8/19/1999) for a personalized greeting card with electronic storage media and method of personalizing same that sufficiently similar to the claimed invention, the differences are no authentication/validate the giving amount of money (however, this missing factor was old and well-known to be obvious in combination with West in achieving

claimed results).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose number is 703-305-4553. The examiner can normally be reached on 7am-330 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, JEFFREY A. SMITH can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

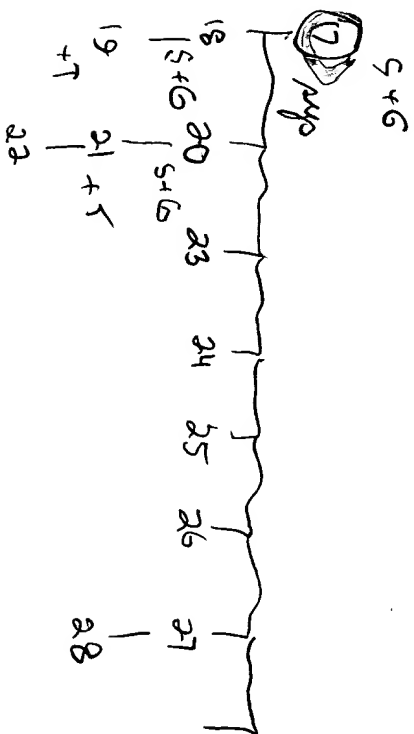
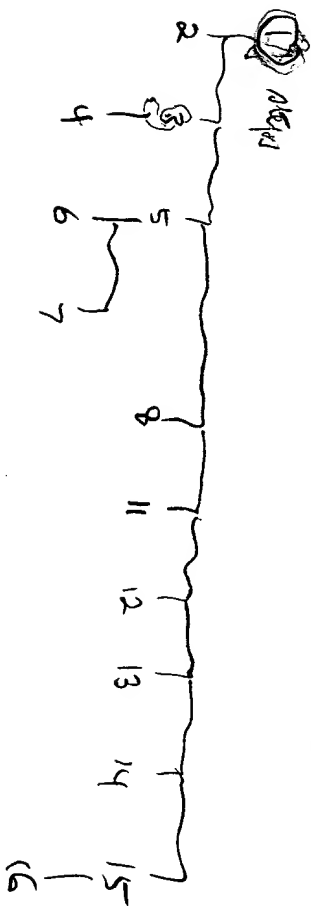
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Cuong H. Nguyen

CUONG H. NGUYEN
Primary Examiner
Art Unit 3625

9/737,912

2/9/04



29 met.

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